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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,635	07/02/2003	Adolf Adrian		3661

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Dr. Max Fogiel
44 Maple Court
Highland Park, NJ 08904

EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,635

Applicant(s)

ADRIAN ET AL.

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of the diaphragm being formed of at least one recess in a sealing seat under the circular ring as first recited in claim 5 and the limitation of the circular ring having a substantially circular-shaped cross-section as first recited in claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Examiner notes that in figure 2 of the instant application a check valve 16,17 comprising a flow through diaphragm or recess in a sealing seat shown in the area of the lead line of number 22 on top of the circular ring 6. For examining purposes, Examiner has interpreted the portions of Applicant's device in the area of piston rod sealing and centering assembly 7 to be considered the bottom of the device so that the sealing seat may be considered as being located under the circular ring 6. Examiner further notes that the views in figures 1 and 2 do not indicate that the cross-section of the circular ring is substantially circular-shaped. Clarification is required.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Examiner reiterates that the specification fails to provide proper antecedent basis for the term "an elastically-tensioned circular ring" first recited in lines 2-3 from the bottom of claim 5 which Examiner has interpreted as element 6 described in the instant specification as a piston rod centering ring. Examiner also notes that the instant specification fails to provide proper antecedent basis for the term "two-cylinder spring-leg" first recited in lines 2-3 of claim 5. Since Applicant has failed to provide antecedent basis for the terms, for examining purposes, Examiner maintains that the ring of GB'903 is an elastically-tensioned circular ring to the same extent as Applicant's.

3. The abstract of the disclosure is objected to because in lines 2-3 of the abstract Applicant makes reference to a two-cylinder telescoping leg. Applicant eliminated this

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terminology from the claims since it was unclear to the Examiner whether the telescoping leg was referring to the piston rod. Correction is required. See MPEP § 608.01(b). The term is also found in the title of the application.

4. A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted in the art to which this invention pertains. For example: the use of the term "diaphragm" to represent a recess is repugnant since Webster's Collegiate Dictionary 10th Edition defines diaphragm as a body partition or a thin flexible disk that vibrates.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 8, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 6 and 11. The phrase "a groove" in line 2 is indefinite. It is unclear to the Examiner whether the groove in claim 6 is intended to be the same or different from the at least one recess in the sealing seat recited in the last two lines of claim 5.

Re: claims 8 and 11. The phrase "a valve" in line 2 is indefinite. It is unclear to the Examiner whether the valve in line 2 of claim 8 is intended to be the same or different from the check valve recited in claim 5.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 5, 7, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by GB-2115903 (GB'903).

Re: claims 5 and 10. GB'903 shows in figure 1 a sealing and guiding arrangement for passage of a piston rod 3 in a two-cylinder dashpot or a two-cylinder spring-leg and for sealing and guiding the piston rod when traveling into and out of the dashpot, comprising: at least one seal 25 for sealing the interior of the dashpot from the outside; at least one radial guide 13 for the piston rod; the two cylinder dashpot having an inner cylinder 1 and an outer cylinder 4, a gas chamber 5 between the outer cylinder and the inner cylinder, a gas channel 10,14,10 extending between the radial guide and the gas chamber, a check valve 19,20 in the gas channel in upstream of the gas chamber as shown and formed as a lipped seal comprising a flow through diaphragm, the lipped seal having a sealing lip 20 on an elastically-tensioned circular ring 6 with substantially circular-shaped cross-section to the same extent as Applicant's, the diaphragm being formed of at least one recess 16 in a sealing seat under the circular ring as best understood interpreting the elements of GB'903 in the area of element 13 to be the bottom of the device.

Re: claim 7. GB'903 shows in figure 1 the limitation of a bushing 7 mounted on an inner surface of the ring for radially securing the piston rod.

Re: claim 9. GB'903 shows in figure 1 an auxiliary seal 27 for sealing the sealing and guiding arrangement from the outer cylinder.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB'903.

Re: claims 6, 8, and 11. GB'903 shows in figure 12 the limitation wherein the sealing lip rests against a surface of a groove shown to the left of portion 20 holding the seal 19,20. GB'903 fails to include the limitation of the surface being conical.

In *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the surface of the groove of GB'903 to have been conical or any other appropriate shape as best determined by routine experimentation, in order to provide a certain sealing capacity depending on the particular application.

Please see the rejection of claims 5 and 7 above with regards to the remaining limitations set forth in claim 11.

Response to Arguments

11. Applicant's arguments filed 12/28/04 have been fully considered but they are not persuasive. Applicant argues that GB'903 fails to anticipate a check valve formed on a sealing lip on a circular elastically tensioned ring having a circular-shaped cross-section. Examiner first notes that the claim language does not recite that the check valve is formed **on** a sealing lip as argued. The claim language states that the check valve is formed **as** a sealing lip. GB'903 shows the limitation of a check valve being formed as a sealing lip 19,20. The sealing lip 19,20 of GB'903 is on a circular elastically tensioned ring 6 having a substantially circular-shaped cross-section to the same extent as Applicant's. Applicant also argues that there is no hint of a flow-through diaphragm which is formed of at least one recess in a sealing seat under the circular ring. First, Examiner notes that GB'903 shows a flow-through diaphragm which is formed of at least one recess shown in the area of element 16 and immediately to the left of element 20 in a sealing seat under the circular ring to the same extent as Applicant's. Accordingly, the rejections using the GB'903 reference have been maintained.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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March 8, 2005


3/12/2005
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PRIMARY EXAMINER
GROUP 310